

APR 24 2006 P. 01

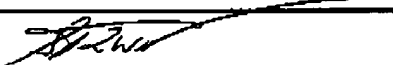
PTO/SB/21 (09-04)

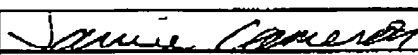
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<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/722,203
		Confirmation Number	6809
		Filing Date	11/25/2003
		First Named Inventor	Corey A. Salzer
		Art Unit	3729
		Examiner Name	Paul D. Kim
Total Number of Pages in This Submission	8	Attorney Docket Number	27441.010

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Credit Card Payment Form (1 page); and Pre-Appeal Brief Request for Review (5 pages).
<b>Remarks</b> It is believed that no additional fees are due in this matter. However, if it is determined that additional fees are due, the Commissioner is authorized to debit Deposit Account No. 502622 for the required fees.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Setter Ollila LLC		
Signature			
Printed Name	Steven L. Webb		
Date	4/24/2006	Reg. No.	44,395

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, fax number (571) 273-8300, addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
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Typed or printed name	Jamie Cameron	Date	4/24/2006

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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 27441.010	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>4/24/2006</u></p> <p>Signature <u><i>Jamie Cameron</i></u></p> <p>Typed or printed name <u>Jamie Cameron</u></p>		Application Number <u>10/722,203</u>	Filed <u>11/25/2003</u>
		First Named Inventor <u>Corey A. Salzer</u>	
		Art Unit <u>3729</u>	Examiner <u>Paul D. Kim</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,395</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.</p>			

  
Signature  
Steven L. Webb  
Typed or printed name  
(303) 938-9999 x 22  
Telephone number  
4/24/2006  
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**APR 24 2006**

**Practitioner's Docket No. 27441.010**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Corey A. Salzer  
Application No.: 10/722,203  
Filed: 11/25/2003  
For: Sonically ablated sensor

Group No.: 3729  
Examiner: Paul D. Kim

**Mailstop: AF  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450**

**Pre-Appeal Brief Request for Review**

In response to the Office Action dated April 12, 2006, please consider the following remarks.

**Remarks**

Claims 1 – 24 are pending. Claims 1 – 12 have been rejected. Claims 13 – 24 are withdrawn from consideration.

Claim 1 has been rejected under 35 U.S.C. 102(e) as being anticipated by Higson (US 6,083,366). Claim 1 is reproduced below:

1. (Original) A method of making a sensor to measure an analyte in a solution, the method comprising:
  - providing a substrate;
  - printing conductive ink on the substrate to form a plurality of electrode regions;
  - depositing an electrical insulation to cover one of the electrode regions;
  - sonically ablating the electrical insulation to form an array of pores through the electrical insulation to the conductive ink in the one electrode region; and
  - depositing metal into the pores to form an array of electrodes in the one electrode region.

Claim 1 requires that metal is deposited into the pores to form an array of electrodes in the one electrode region. Higson does not use metal. Higson clearly states that a conducting organic polymer is deposited into the pores (see column 2 lines 15 – 20). The current application identifies the prior art of using a conducting organic polymer in the background section on page 2, lines 14 – 19. The advantage of using metal instead of conducting organic polymers is that “The metal in the pores provides better sensitivity than a conducting organic polymer for some applications, such as chlorine detection” (see page 7, lines 5 – 6 of the current application). Because Higson does not deposit metal to form an array of electrodes the examiner has not established a *prima facie* case for anticipation, and claim 1 is allowable as written.

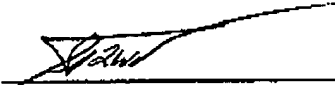
In the response to arguments section of the current office action the examiner states “The conducting organic polymer used in Higson contains the metal capable of electrically connecting between electrodes”. The examiner has made an incorrect, unsupported statement. First, the statement is incorrect because conducting organic polymers do not use metal to conduct electricity. Conducting organic polymers use their

long molecule chemical structure to conduct electricity. Second, Higson does not teach that conducting organic polymers use or contain metal.

Claims 1 – 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Higson (US 6,083,366) in view of Uchida et al. (4,464,244) or Satou (JP 11163055 A). As stated above, Higson does not deposit metal into pores to form an array of electrodes. Neither Uchida, nor Satou, deposit metal into pores to form an array of electrodes. The metal filled holes in Uchida and in Satou are used for a completely different purpose than the array of electrodes in the current invention. An electrode is defined as a conductor (as a metallic substance or carbon) used to establish electrical contact with a nonmetallic portion of a circuit. *Webster's Third New International Dictionary, Unabridged*. Merriam-Webster, 2002. (emphases added). Uchida fills a few holes with metal to form an electrical connection between two conducting layers in an electronic circuit. The metal filled holes in Uchida are not electrodes. The holes in Uchida certainly don't form an array of electrodes. The metal in Uchida is used to join together different layers in the circuit, like soldering two wires together. Satou also fills hole with metal to form an electrical connection between two conductive sections of an electrical circuit. As discussed above, connecting two metallic sections of a circuit by filling a hole with metal, does not teach creating an array of electrodes. Therefore the examiner has not established a *prima facie* case for obviousness and claims 1 – 10 are allowable as written.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). There is no suggestion in either Uchida or Satou to modify Higson to use metal instead of the conducting organic polymer in Higson. Furthermore the examiner has not presented a convincing line of reasoning as to why someone skilled in the arts would have found the claimed invention to have been obvious in light of the teachings of the references. Therefore the examiner has not established a *prima facie* case for obviousness and claims 1 – 10 are allowable as written.

Claims 11 – 12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Higson (US 6,083,366) in view of Uchida et al. (4,464,244) or Satou (JP 11163055 A) and in further view of Hall et al. (4,242,379). Claims 11 and 12 are dependent on allowable claim 1, and are therefore allowable.



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**SIGNATURE OF PRACTITIONER**  
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